



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,097	04/06/2001	Victor Skladnev	3415/56	2721

7590

01/28/2003

Gottlieb Rackman & Reisman
270 Madison Avenue
New York, NY 10016-0601

EXAMINER

FUQUA, SHAWNTINA T

ART UNIT

PAPER NUMBER

3742

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,097

Applicant(s) *my*

SKLADNEV ET AL.

Examiner

Shawntina T. Fuqua

Art Unit

3742

-- Th MAILING DATE of this communication app ars on th cov r she t with th corr spond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

2. Claims 7 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 7 and 10 are method claims which depend from apparatus claims 1 and 9 and do not further limit the subject matter of the apparatus claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al (US5630426).

Eggers et al discloses a tissue type recognition system for determining a type of unknown tissue comprising a tip (22), a shaft (23) for coupling the tip to a handle (21), a plurality of

Art Unit: 3742

electrodes (51-56, column 3, lines 65-66), tissue recognizing circuitry coupled to electrodes (column 3, line 65-column 4, line 1), wherein the circuitry injects electrical current into tissue via electrodes for measuring at least two unique electrical properties of tissue and each of the electrical properties is compared with corresponding electrical properties of known tissue types to determine the type of unknown tissue (column 5, lines 24-30, 44-47, 51-column 6, line 51), electrodes are used in pairs to measure a pulse response of tissue (column 5, lines 24-30, 52-64), each of plurality of electrodes are used to perform a terminal conductivity (column 6, lines 24-40), contact between electrodes and tissue is checked by making measurements of adjacent pairs of electrodes (column 6, lines 13-41), current is at a frequency of at least 100kHz (column 6, lines 9-12), tip comprises a large electrode (51), and electrodes are arranged in a number of rows (Figure 2, column 4, lines 49-52).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggars et al in view of Skladnev et al (US6026323).

Eggars et al discloses all of the recited subject matter except using discriminant analysis, determining the presence of abnormal tissue in a cervix comprising the steps of measuring an electrical conductivity via a pair of electrodes, measuring a pulse and decay property of cervical

Art Unit: 3742

tissue via a second pair of electrodes, and combining conductivity and pulse and decay properties to differentiate between normal and abnormal cervical tissue (column 3, lines 38-44; column 5, lines 41-44, 61-63; column 6, lines 3-17, 49-67; column 7, lines 1-7, 28-60; column 8, lines 21-37; column 10, line 47-column 11, line 20; claims). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the discriminant analysis and method of Skladnev et al in the apparatus of Eggers et al because, discriminant analysis and a method for determining the presence of abnormal tissue in a cervix identifies cancerous and precancerous tissue more efficiently.

Allowable Subject Matter

7. Claims 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawntina T. Fuqua whose telephone number is (703) 305-2581. The examiner can normally be reached on Monday-Friday 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3463 for regular communications and (703) 305-3463 for After Final communications.

Application/Control Number: 09/807,097

Page 5

Art Unit: 3742

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

stf

January 22, 2003


Teresa Walberg
Supervisory Patent Examiner
Group 3700